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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,041	06/20/2003	George Gutman	2088	6393

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ENERGY CONVERSION DEVICES, INC.
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ROCHESTER HILLS, MI 48309

EXAMINER

VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,041

Applicant(s)

GUFMAN

Examiner

Mathieu D. Vargot

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/25/2004.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. Claims 28-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 28 and 29 are dependent on an apparatus claim and yet call for "the method of claim 19" at line 1 which requires correction. Also, claims 30-32 should contain structural language as these are apparatus claims—in essence, the claims are indefinite without some structure or means language in them.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Kokai 2-182,433 in view of Japanese document 8-221,812 and either of Rowland (see col. 10, lines 37-47) or Hannan et al (see col. 5, lines 58-61). Japanese —433 discloses the basic claimed process and apparatus for forming an information carrier by providing a web of plastic material, adapting it to flow in and out of a stamp zone between first and second platens, at least one of which has a stamper with a flat, microstructured surface which has been heated inductively to some temperature so that the image can be embossed onto the web. Essentially, the primary reference fails to disclose a punch nip on one of the platens and a clear showing that the web is heated to a temperature above its glass transition temperature. Japanese

Art Unit: 1732

—812 discloses a punch member 80 which is contained in one platen and which extends through a hole in the other platen or die to make a hole in an information carrier. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the method and apparatus of the primary reference as taught by Japanese —812 to form a central hole in the carrier, such being nothing but conventional in the art so the disk can be played on conventional disk players. Rowland discloses forming microstructures on a web of material by heating the web to a temperature above its glass transition temperature—see column 10, lines 37-47. While Rowland discloses that the temperature should be so high that the web is basically in a melt state, it is conventional knowledge in the art that the impressing would be done at temperatures lower than the flow temperature—but above the glass transition temperature—by simply using more pressure. At any rate, Hannan et al is additionally applied to show that the embossing of a web should be done at temperatures below the flow temperature. Abased on the teachings of Rowland and Hannan et al, one of ordinary skill would realize that the web in the primary reference would have obviously been heated to above its glass transition temperature to facilitate the embossing. The exact thickness of the web and the embossing time would have been obvious as such are result effective variables readily determined through routine experimentation.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1732

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 11/057,636. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims set forth a similar method of forming microstructures on the surface of a web of polymeric material by heating a stamper and either embossing the web—the instant—or melt forming the microstructures by melt flowing the web into the image forming area. While the instant claims call for embossing, it is well known that the exact temperature used is a result effective variable which depends on the pressure applied. I.e., it would have been obvious to have modified the method of the copending application to heat below the melt temperature should an embossing rather than a melt forming be desired. While the claims of 11/057,636 lack a recitation of first and second platens, such are well known in the art and would have been obvious modifications to the method of the copending application to facilitate the forming.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 44 of copending

Art Unit: 1732

Application No. 10/185,246. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims set forth a similar method of forming microstructures on the surface of a web of polymeric material by heating a stamper and either embossing the web—the instant—or melt forming the microstructures by melt flowing the web into the image forming area. While the instant claims call for embossing, it is well known that the exact temperature used is a result effective variable which depends on the pressure applied. Ie, it would have been obvious to have modified the method of the copending application to heat below the melt temperature should an embossing rather than a melt forming be desired. While the claims of 10/185,246 lack a recitation of first and second platens, such are well known in the art and would have been obvious modifications to the method of the copending application to facilitate the forming.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 10/702,377. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims set forth a similar method of forming microstructures on the surface of a web of polymeric material by heating a stamper and embossing the web. As already pointed out, it would be conventional wisdom to heat the web/stamper to a temperature above the glass

Art Unit: 1732

transition temperature and such would have been an obvious feature in the process of copending application 10/702,377 to facilitate the embossing.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of copending Application No. 10/465,250. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims set forth a similar method of forming microstructures on the surface of a web of polymeric material by heating a stamper and either embossing the web—the instant—or melt forming the microstructures by melt flowing the web into the image forming area. While the instant claims call for embossing, it is well known that the exact temperature used is a result effective variable which depends on the pressure applied. I.e., it would have been obvious to have modified the method of the copending application to heat below the melt temperature should an embossing rather than a melt forming be desired.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone

Art Unit: 1732

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
September 30, 2005


Mathieu D. Vargot
Primary Examiner
Art Unit 1732

9/30/05